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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/634,725	08/05/2000	Naren Chaganti	PSCO-007	2559

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EXAMINER	
LANIER, BENJAMIN E	

ART UNIT	PAPER NUMBER
2432	

NOTIFICATION DATE	DELIVERY MODE
01/05/2012	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	09/634,725	CHAGANTI, NAREN	
	Examiner	Art Unit	
	BENJAMIN LANIER	2432	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 December 2011*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5)☒ Claim(s) *45-61* is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *45-61* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

12)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 December 2011 has been entered.

Response to Amendment

2. Applicant's amendment filed 16 December 2011 cancels claims 1-44. Claims 45-61 have been added. Applicant's amendment has been fully considered and entered.

Response to Arguments

3. Applicant argues, "the office action appears to have overlooked that Ser. No. 09/478,796 described copyrighting information objects and using copyrighting to control the use of the information objects…" In response, the description of the controlled use of copyright-protected information objects is broader than what is being claimed. For instance, the '796 disclosure is silent with respect to the determining the number of simultaneous users who could access the copyright-protected information object.

4. Applicant argues, "Glassman teaches away from the instant claims under examination…" This argument is not persuasive because Glassman does not teach away from the proposed modification of Manolis as proposed.

5. In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the online print service of Manolis to provide licensed access to copyrighted images in order to provide account users with the ability control access to their copyrighted images at the same time providing concurrent access to the images as suggested by Glassman (Col. 1, lines 55-62 & Col. 2, lines 27-31).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 46 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not support the limitation requiring prohibiting retransmission of the copyright-protected information object. The specification (Page 23) merely discloses that retransmission of copyright-protected objects could be "forbidden". Meaning that there are legal ramifications for individuals that are caught retransmitting copyright-protected objects.

However, the specification does not disclose any mechanisms to actually prevent the retransmission from occurring. For the purpose of examination, the claim will be treating as forbidding retransmission based on the objects designation as copyright-protected.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 53-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim elements "data communication module", "account establishment module", "database interface module", "security module", and "locking mechanism" are limitations that invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. The claims use non-structural terms (module and mechanism) coupled with functional language.

11. Applicant may:

(a) Amend the claim so that the claim limitation will no longer be interpreted as a limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification and linked or associated to the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 45-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manolis, U.S. Patent No. 7,243,079, in view of Glassman, U.S. Patent No. 6,453,305. Referring to claim 45-50, 52-56, 61, Manolis discloses an online print service wherein users are able to sign up for an account (Figure 5, 51) by providing user information (Figure 7). The user's account has an associated URL (Col. 9, line 55), which meets the limitation of assigning an address for the first user's online repository. Once the user creates an account, they can upload images (Figures 11-12) to the online print service database (Figure 3, 330), which meets the limitation of establishing on the server computer connected to the Internet an account for each of a plurality of

users, storing on the server computer a information object, wherein the information object is an image, a data communications module capable of establishing a connection with the Internet said Internet being capable of sending and/or receiving one or more information objects, each said information object comprising voice, video, data, text and/or any combinations thereof, the user's device is a client computer. Manolis does not disclose that the images can be copyrighted images that are bound by license restrictions. Glassman discloses providing licensed access to copyrighted content for a period of time (Abstract & Col. 1, lines 42-50), which meets the limitation of copyright-protected information object, controlling access to the copyright-protected information object by one or more of the plurality of users in accord with one or more restrictions, prohibiting retransmission of the copyright-protected information object, prohibiting use of the copyright-protected information object beyond a predetermined time, receiving license information for the copyright-protected information object, said license information indicating that the license is for access of the information object for a predetermine time ($T_{license}$), permitting access of the copyright-protected information object in accordance with the time constraint imposed by the license information, and disabling access to the copyright-protected information object upon expiration of the predetermined time ($T_{license}$), determining a time period (T) during which the copyright-protected information object may be accessed, and allowing the copyright-protected information object to be accessed during that time (T), and disabling access to the copyright-protected information object upon expiration of that time period (T). Glassman discloses concurrent N-user license (Col. 1, lines 55-62). If no licenses are available, the requestor is provided with a time that a license should become available (Col. 6, lines 12-19), which meets the limitation of examining license information for the copyright-protected

information object to determine a number N (where N≥1) of simultaneous users who could access the copyright-protected information objects, and allowing no more than N simultaneous users to access the copyright-protected information object, a locking mechanism configured to prevent access to the copyright-protected information object more than N times simultaneously. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the online print service of Manolis to provide licensed access to copyrighted images in order to provide account users with the ability control access to their copyrighted images at the same time providing concurrent access to the images as suggested by Glassman (Col. 1, lines 55-62 & Col. 2, lines 27-31).

Referring to claims 51, 57-59, Manolis discloses that the shared images are displayed in a format suitable for the recipient's browser (Figure 27), which meets the limitation of formatting the copyright-protected information object suitable to the requirements of a user's device, the formatter is capable of selecting a suitable format from a database of formats to format the copyright-protected information object, wherein the formatter is capable of selecting a set of stored rules to format the copyright-protected information object.

Referring to claim 60, Manolis discloses that the shared images are displayed as thumbnails (Figure 27), which meets the limitation of the formatter formats the information object to fit the screen of said client device.

15. Claims 48, 54, 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer, U.S. Publication No. 2001/0031066, in view of Glassman, U.S. Patent No. 6,453,305. Referring to claims 48, 54, 55, Meyer discloses a server that stores an online content library linked to particular user identity, where each library includes content title information ([0093]-[0095]). A

user transmits content having an identifier to the server, externally accessible via the Internet, that maintains content libraries for individual users indentified by usernames and passwords ([0093]-[0094]), which meets the limitation of establishing on the server computer connected to the Internet an account for each of a plurality of users, storing on the server computer a copyright-protected information object, a data communications module capable of establishing a connection with the Internet said Internet being capable of sending and/or receiving one or more information objects, each said information object comprising voice, video, data, text and/or any combinations thereof. License information is stored along with the content in the online library and dictates how the content may be access ([0030] & [0057] & [0073]), which meets the limitation of controlling access to the copyright-protected information object by one or more of the plurality of users in accord with one or more restrictions. Meyer does not disclose utilizing concurrent use licenses. Glassman discloses concurrent N-user license (Col. 1, lines 55-62), which meets the limitation of examining the license information for the copyright-protected information object to determine a number N, (where $N \geq 1$) of simultaneous users who could access the copyright-protected information object, allowing no more than N simultaneous users to access the copyright-protected information object, a locking mechanism configured to prevent access to the copyright-protected information object more than N times simultaneously. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the licenses of Meyer to include concurrent use licenses as described in Glassman in order to provide concurrent access to the content as taught by Glassman (Col. 1, lines 55-62).

16. Claims 49, 50, 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer, U.S. Publication No. 2001/0031066, in view of Atkinson, U.S. Patent No. 6,367,012. Referring

to claims 49, 50, 56, Meyer discloses a server that stores an online content library linked to particular user identity, where each library includes content title information ([0093]-[0095]). A user transmits content having an identifier to the server, externally accessible via the Internet, that maintains content libraries for individual users indentified by usernames and passwords ([0093]-[0094]), which meets the limitation of establishing on the server computer connected to the Internet an account for each of a plurality of users, storing on the server computer a copyright-protected information object, a data communications module capable of establishing a connection with the Internet said Internet being capable of sending and/or receiving one or more information objects, each said information object comprising voice, video, data, text and/or any combinations thereof. License information is stored along with the content in the online library and dictates how the content may be access ([0030] & [0057] & [0073]), which meets the limitation of controlling access to the copyright-protected information object by one or more of the plurality of users in accord with one or more restrictions. Meyer does not disclose that the license expires after a period of time. Atkinson discloses utilizes licenses with an expiration (Col. 9, lines 60-61), which meets the limitation of information indicating that the license is for access of the information object for a predetermine time ($T_{license}$), permitting access of the copyright-protected information object in accordance with the time constraint imposed by the license information, and disabling access to the copyright-protected information object upon expiration of the predetermined time ($T_{license}$), determining a time period (T) during which the copyright-protected information object may be accessed, and allowing the copyright-protected information object to be accessed during that time (T), and disabling access to the copyright-protected information object upon expiration of that time period (T), the one or more restrictions include a

limitation of the time during which a user may access the copyright-protected information object. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the licenses of Meyer to include expirations in order to limit the periods that the content can be access and therefore susceptible to unauthorized access as suggested by Atkinson (Col. 9, lines 60-65).

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN LANIER whose telephone number is (571)272-3805. The examiner can normally be reached on M-Th 7:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin E Lanier/

Primary Examiner, Art Unit 2432